



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Patent Application of	)	
	)	
Sampath SRINIVAS et al.	)	Group Art Unit: 2155
	)	
Application No.: 09/706,296	)	Examiner: D. Lazaro
	)	
Filed: November 3, 2000	)	
	)	
For: DYNAMIC TOOLBAR FOR	)	
MARKUP LANGUAGE DOCUMENT	)	

**TRANSMITTAL FOR REPLY BRIEF**

U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop Appeal Brief-Patents  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

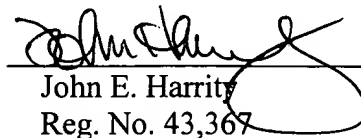
Sir:

Submitted herewith is Appellant's Reply Brief in response to the Examiner's Answer  
mailed April 6, 2005, in the above-identified application.

The Commissioner is hereby authorized to charge any other appropriate fees that may be  
required by this paper that are not accounted for above, and to credit any overpayment, to  
Deposit Account No. 50-1070.

Respectfully submitted,

HARRITY & SNYDER, L.L.P.

By:   
John E. Harrity  
Reg. No. 43,367

11240 Waples Mill Road  
Suite 300  
Fairfax, Virginia 22030  
(571) 432-0800  
CUSTOMER NUMBER: 44987

Date: June 6, 2005



PATENT  
Attorney Docket No. 0023-0219

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of	)	
	)	
Sampath SRINIVAS et al.	)	Group Art Unit: 2155
	)	
Application No.: 09/706,296	)	Examiner: D. Lazaro
	)	
Filed: November 3, 2000	)	
	)	
For: DYNAMIC TOOLBAR FOR	)	
MARKUP LANGUAGE DOCUMENT	)	

**REPLY BRIEF UNDER 37 CFR § 1.193**

U.S. Patent and Trademark Office  
Customer Window, **Mail Stop Appeal Brief - Patents**  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

This Reply Brief is submitted in response to the Examiner's Answer, mailed April 6, 2005.

In the Response to Arguments section of the Examiner's Answer (pages 8-25), Appellants provide the following remarks.

**Arguments with respect to claim 1**

The Examiner alleges that "the rejection does not state that Guthrie does not disclose 'inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser'" (Examiner's Answer, pg. 11. Therefore, it appears, for the first time in the Examiner's Answer, as if the Examiner is now alleging that Guthrie discloses

this feature. Yet, the Examiner admits on the very same page of the Examiner's Answer that Guthrie "does not explicitly teach inserting a script into 'each frame' of a webpage with multiple frames" (Examiner's Answer, pg. 11). It is unclear how the Examiner can reasonably allege that Guthrie discloses the very feature that the Examiner admits that Guthrie does not disclose.

Nonetheless, as set forth in detail in the Appeal Brief, filed January 14, 2005, Guthrie appears to disclose the ability to inject a user interface component 305 into an HTML document (Fig. 3; col. 5, lines 35-45). As illustrated in Fig. 3, Guthrie discloses an HTML document that includes three pre-existing frames 306, 307, and 308 and a single user interface component 305, which the Examiner alleges corresponds to the recited toolbar (Examiner's Answer, pg. 4). Guthrie specifically discloses that Guthrie's system ensures that only one instance of injectable component 305 is generated and displayed in browser application window 303 (Fig. 3; col. 5, lines 59-67). Thus, Guthrie not only does not disclose or suggest inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser, as required by claim 1, but **specifically teaches away** from this feature.

The Examiner also alleges that "Pacifci is cited to show the subject matter of inserting a script into each frame of a webpage with multiple frames" (Examiner's Answer, pg. 13). Appellants note, however, that claim 1 does not recite inserting a script into each frame of a webpage, but specifically recites inserting an executable script into each frame of a webpage operable to render a toolbar in each frame. As set forth in detail in the Appeal Brief, Pacifci et al. discloses the ability to add HTML annotations to HTML documents (see, for example, col. 2, lines 59-67). Pacifci et al. does not disclose or suggest, however, that these annotations are

executable script or, more importantly, executable script operable to render a toolbar in each frame of a webpage, as required by claim 1. The Examiner acknowledges this fact in the Examiner's Answer (Examiner's Answer, pg. 13). The Examiner has not explained, however, why Pacifici et al.'s teaching of inserting annotations into an HTML document would lead one skilled in the art to alter the very operation of the Guthrie system to include the ability to insert an executable script into each frame of a webpage operable to render a toolbar in each frame when executed by a client browser, as required by claim 1.

The Examiner makes repeated statements in the Examiner's Answer regarding Appellants not considering what the combination of Guthrie and Pacifici et al. would have suggested to one of ordinary skill in the art (see, for example, pg. 14 of the Examiner's Answer). As set forth above, Guthrie specifically teaches away from modifying the Guthrie system to include the ability to insert an executable script into each frame of a webpage operable to render a toolbar in each frame when executed by a client browser, as required by claim 1. Guthrie specifically discloses that Guthrie's system ensures that only one instance of injectable component 305 is generated and displayed in browser application window 303 (Fig. 3; col. 5, lines 59-67). Thus, Guthrie not only does not disclose or suggest inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser, as required by claim 1, but **specifically teaches away** from this feature. The Examiner's attempt at reconstructing Appellants' claim 1 is clearly based on impermissible hindsight.

Further with respect to motivation, the Examiner alleges "the motivation to combine Guthrie and Pacifici is self evident in Guthrie. Specifically, the examiner cited Col. 3 lines 1-29

as it describes the need for a user to be able to incorporate add-on components in a webpage including webpages with multiple frames. The need and desire come from benefits such as easier navigation, for example, (Col. 3 lines 7-9). If there is need or desire for an end result, it is logical that one would be open to modifications and alternatives to achieve the end result" (Examiner's Answer, pg. 17). Appellants strenuously disagree with the Examiner's position.

At the outset, Appellants note that col. 3, lines 1-29, of Guthrie does not, as alleged by the Examiner, describe the "need for a user to be able to incorporate add-on components in a webpage, including webpages with multiple frames." Instead, this section of Guthrie discloses that a user may incorporate add-on components in a webpage that is displayed by a browser application. Appellants strongly object to the Examiner's attempt at construing this section of Guthrie as implying the desire to incorporate add-on components into each frame of a webpage. The Examiner's allegation is unsupported by the Guthrie disclosure.

Moreover, this section of Guthrie further supports Appellants' position that Guthrie teaches away from incorporating add-on components into each frame of a webpage, as required by claim 1. At col. 3, lines 27-30, Guthrie discloses:

Also, the injection mechanism is able to ensure that the add-on component is generated only under certain conditions, for example, when the component is not already being displayed by the browser application.

This section of Guthrie specifically discloses Guthrie's desire to ensure that only one add-on component is displayed by a browser application.

For at least these additional reasons, Appellants request that the rejection of claim 1 under 35 U.S.C. § 103(a) based on Guthrie and Pacifici et al. be reversed.

Arguments with respect to claim 7

The Examiner's arguments with respect to claim 7 continue to ignore the specific features recited in claim 7. For example, claim 7 recites "determining a size of each frame in which the toolbar is to be displayed using the activation script inserted into each frame." The Examiner alleges that "Guthrie in view of Pacifici has shown the insertion of the script into each frame to render a toolbar in each frame is obvious" (Examiner's Answer, pg. 18). For at least the reasons given above and for those reasons set forth in detail in the Appeal Brief, Appellants respectfully disagree. The Guthrie disclosure specifically teaches away from inserting an executable script into each frame of a webpage operable to render a toolbar in each frame when executed by a client browser, as required by claim 7.

The Examiner further alleges that "[t]he scope of Guthrie in view of Pacifici also teaches conditionally displaying a toolbar based on conditions determined by the activation script" (Examiner's Answer, pg. 18). The Examiner conveniently ignores the fact that Guthrie specifically discloses that the condition is to insert the add-on component only when the component is not already displayed (col. 6, lines 49-51). Thus, Guthrie specifically teaches away from inserting an executable script into each frame of a webpage operable to render a toolbar in each frame when executed by a client browser.

Guthrie in no way discloses or suggests that injected code 408 is used for determining a size of each frame in which the toolbar is displayed, as required by claim 7. The Examiner appears to rely on Kanevsky for allegedly disclosing conditionally adding webpage components

depending on the size of the viewing area (Examiner's Answer, pg. 18). Regardless of the veracity of this allegation, Kanevsky does not disclose or suggest, as set forth in detail in the Appeal Brief, determining the size of each frame using an activation script inserted into each frame, as required by claim 7. The Examiner does not explain how this alleged teaching of Kanevsky relates to this feature of claim 7.

The Examiner further alleges in the Examiner's Answer, that "Appellants arguments with regard to Kanevsky, seem to conflict. On page 12 of the Appeal Brief, Appellants state that Col. 10, lines 45-62 of Kanevsky '*discloses determining whether to render objects...based on the size of the objects and the screen size.*' Then, on the same page, in regards to a certain embodiment of Kanevsky, Appellants state, '*Kanevsky does not disclose or suggest determining a size of a screen*'" (Examiner's Answer, pg. 19). Appellants strenuously object to the Examiner's mischaracterization of Appellants' arguments.

While Appellants admit that Kanevsky discloses determining whether to render objects (described by Kanevsky as icons, text, and graphic images - see, for example, col. 10, lines 45-62) based on the size of the objects and the screen size, Appellants submit that Kanevsky does not disclose or suggest determining a screen size, let alone a frame in which a toolbar is to be displayed, using an activation script inserted into each frame, as required by claim 7. This argument was clearly set forth in the Appeal Brief (see page 12).

For at least these additional reasons, Appellants request that the rejection of claim 1 under 35 U.S.C. § 103(a) based on Guthrie, Pacifici et al., and Kanevsky be reversed.

Arguments with respect to claim 17

On pages 21-23 of the Examiner's Answer, the Examiner seems to compare features recited in Appellants' claim 1 to features recited in Appellants' claim 17. Such comparisons are not relevant to the patentability of claims 1 and 17 and Appellants respectfully request that any determination of the patentability of claims 1 and 17 be based on the specific language recited in those claims and not on the Examiner's attempts at comparing these claims.

With respect to Appellants' arguments on page 14 of the Appeal Brief regarding Guthrie teaching away from rendering a toolbar in each of the frames of the webpage when the size of a frame exceeds a threshold and not rendering the toolbar in each of the frames of the webpage when the size of a frame does not exceed the threshold, as required by claim 17, the Examiner alleges that "the fact that Guthrie discloses such a checking mechanism further supports the interpretation that Guthrie expects other embodiments where multiple toolbars can be potentially displayed in multiple frames. Otherwise, why would there be such a checking mechanism" Examiner's Answer, pg. 24). Appellants submit that the Examiner has misconstrued the disclosure of Guthrie.

Guthrie specifically discloses that Guthrie's injection system ensures that only one instance of the injectable component is generated and displayed in the browser application window (see col. 5, lines 63-67). Contrary to the Examiner's allegation, Guthrie does not disclose that other embodiments exist where Guthrie desires more than one instance of the injectable component to be generated and displayed. The Examiner has not pointed to any

section of Guthrie that supports this allegation.

As to Guthrie's "checking mechanism," as referred to by the Examiner, Guthrie discloses that a web browser 401 receives an HTTP-response 409 that includes injected code 408 that contains instructions that cause web browser 401 to conditionally insert HTML tag statements (HTML code) into document 407 when the browser executes the injected code (Fig. 4; col. 6, lines 41-46). The HTML code is used by web browser 401 to generate and display an instance of the injectable component (col. 6, lines 46-48). When the injected code is executed by web browser 401, it is determined whether another instance of the injectable component is already displayed. If another instance is not already displayed, then web browser 401 creates an instance of the component (col. 6, lines 48-56). Thus, Guthrie's "checking mechanism" ensures that only one instance of the injectable component is displayed. Contrary to the Examiner's allegation, the above "checking mechanism" in no way implies that Guthrie discloses that other embodiments exist where Guthrie desires more than one instance of the injectable component to be generated and displayed. The Examiner's allegation is unsupported by the Guthrie document.

For at least these additional reasons, Appellants request that the rejection of claim 1 under 35 U.S.C. § 103(a) based on Guthrie, Kanevsky, and Chennapragada et al. be reversed.

CONCLUSION

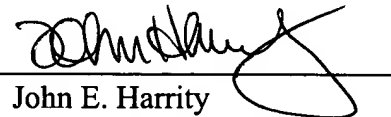
In view of the foregoing arguments, Appellants respectfully solicit the Honorable Board to reverse the outstanding rejections of claims 1-4, 6-10, 17-20, and 22.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1070 and please credit any excess fees to such deposit account.

Respectfully submitted,

HARRITY & SNYDER, L.L.P.

By: \_\_\_\_\_

  
John E. Harrity  
Registration No. 43,367

Date: June 6, 2005

11240 Waples Mill Road  
Suite 300  
Fairfax, Virginia 22030  
(571) 432-0800